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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,094	09/22/2003	Zvi Orbach	154682-0004	4664
29000	7590	04/06/2006	EXAMINER	
IRELL & MANELLA LLP 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	90/006,197, 10/668,094 4949257	
	<b>Examiner</b>	<b>Art Unit</b>
	Andrew J. Fischer	3627

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 February 2006.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-18 and 77 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-18 and 77 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date . . . . .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: . . . . .

## **DETAILED ACTION**

### *Acknowledgements*

1. The amendment filed February 15, 2006 is acknowledged. Accordingly, claims 1-18 and 77 remain pending.
2. This Office Action is given Paper No. 20060403.

### *Claim Rejections - 35 USC §102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, 12, 13, 15, 16, and 77 are rejected under 35 U.S.C. §102(e) as being anticipated by Freeny, Jr. (U.S. 4,528,643) (“Freeny”). Freeny discloses the following:

Freeny discloses the following: memory (within 86) located at the point of sale (“POS”) terminal(s) (14 is a part of the POS); the POS terminal(s) including customer interface means for receiving a software select customer choice input (a keyboard); means for writing software (24, includes a standard diskette drive and the head doing the actual writing of the software, see also column 21, lines 20-21; 24 could also be printers, see column 22, lines 46-47) selected by a

customer from the memory onto a software carrier (floppy disk); means for associating an identification code (owner codes, catalog reproduce code, or catalog transmit code) with software provided to a customer, the means for associating comprises means for embedding said identification code on the software (within 24); the memory may be at a local or remote location or at the POS terminal (12 may be a local or remote location then transferred to memory at the POS terminal before written to the medium); means identifying means of payment (program code embedded with 110); means for preventing copying (owner codes, decipher program, etc); the memory may be remote from the POS terminal and connected with a modem (88); the standard diskette drive inherently includes means for dispensing (how else would the diskette be removed?); a sales receipt is a sales report in hard copy including date of purchase on the sales receipt; the monitor, memory, and program embedded within the memory generate and display a menu; and the system is capable of allowing the customer to operate the software (the computers are general purpose computers); means for providing a potential customer the opportunity for operating the software prior to a decision to purchase (the object itself such as music playing the retail establishment; alternatively takes the object home and never purchases the software or music but merely retains a license to use the software or music).

6. The Examiner notes that Freeny directly discloses software and CPU as the “means for associating an identification code with the selected software provided to the customer . . .” in other words, Freeny uses a “catalog code” and “IMM code” to track albums or other content. See Freeny, C13, L14-17. It is axiomatic that during the normal and usual operation of Freeny’s system, the computer software must translate the “catalog code” and/or “IMM Code” into the

proper content and then send that content back to the information manufacturing machine 14 before the content can be provided by reproduction unit 24.

7. In this interpretation, the “means for associating . . .” does not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph because the phase fails Prong 3. In other words, the corresponding structure for performing the function the means for associating is recited in the claim because the corresponding structure in the “means for embedding” is that structure.

#### ***Claim Rejections - 35 USC §103***

8. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10, 12, 13, 15, 16, and 77 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Freeny. This is an alternative rejection that assumes the “means for associating” clause is a separate clause with its own corresponding structure which is independent from the corresponding structure of the “means for embedding . . .”

10. Therefore in this alternative rejection the phrase “said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase” is the credit card authorization information (credit card number, name of purchase, date of purchase, merchant, etc.). Again, in this alternative rejection, the identification code is the credit card number provided. In this interpretation, Freeny

“associates” the credit card number with the selected software by associating payment with the selected software. Freeny checks to see if the appropriate payment is made for the particular album selected. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Freeny and interpret the credit card number as the identification code. Such a modification would have ensured that the proper payment for the particular album selected was in fact made.

11. Furthermore, it is the Examiner’s position that in this rejection, “said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase” is considered non functional descriptive material.

12. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Freeny to include inputting *e.g.* purchaser identification such as credit authorization information into the manufacturing control unit 34. In fact, Freeny directly states at C13, ~ L44-48:

Also, it should be noted that various other data could be inputted into the manufacturing control unit 34 in connection with a request reproduction code for inventory of material objects control or other general accounting data, if desired.”

13. Thus, because Freeny allows the user to input “other various data,” the structure in Freeny clearly discloses the capacity to write (using reproduction unit 24) data associated with the acquired credit card (*e.g.* name of purchaser taken from the credit card). In light of this capacity and as a matter of law, the use of non functional descriptive material is not enough to distinguish the claimed invention over the prior art.

14. Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Freeny in view of Nitatori et. al. (U.S. 5,046,042)(“Nitatori”). Freeny discloses as discussed above and directly

discloses among other things floppy disks, phonograph records and video disks to store data (column 5, lines 45-59). Freeny does not directly disclose CD-ROMs to store data. Nitatori however discloses the general use of CD-ROMs to store data.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Freeny as taught by Nitatori to include CD-ROMs to store data. Such a modification would have allowed for more efficient storage of data.

15. Claims 14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeny in view of Scarbrough (U.S. 4,314,356)(“Scarborough”). Freeny discloses as discussed above but does not directly disclose a key word search. Scarborough teaches a key word search to search predetermined words or terms.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Freeny as taught by Scarborough to include key word search means enabling a potential purchaser to search available programs via key words in their names and descriptions. Because this is a digital computer, one of ordinary skill in the art could clearly implement a key word searching system in Freeny. Such a modification would have provided a faster way of searching for the desired information.

*Reissue*

16. In accordance with 37 C.F.R. §1.175(b)(1), a supplemental reissue oath/declaration under 37 C.F.R. §1.175(b)(1) must be received before this reissue application can be allowed.

Claim 77 is rejected as being based upon a defective reissue oath under 35 U.S.C. §251. See 37 C.F.R. §1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

***Response to Arguments***

17. Applicant’s arguments filed February 15, 2006 have been fully considered but they are not persuasive.
18. Because of the claim amendments, all 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections have been withdrawn.

***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (571) 272-6779.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "AJ Fischer 4/3/06". The signature is fluid and cursive, with "AJ" at the top, "Fischer" in the middle, and "4/3/06" at the end.

Andrew J Fischer  
Primary Examiner  
Art Unit 3627

AJF  
April 3, 2006